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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,701	01/05/2001	Allan S. Hoffman	UWOTL119001	3998

26389 7590 06/15/2006

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EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/755,701	Applicant(s) HOFFMAN ET AL.	
	Examiner MY-CHAU T. TRAN	Art Unit 1639	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: Interview Summary.

PETER PARAS, JR.
PRIMARY EXAMINER

Peter Paras

ADVISORY ACTION (CONT.)

Response to Arguments

1. Applicant's request for reconsideration because the reasoning set forth in the Advisory Action remains unclear to applicants with regard to the non-entry of the amendment filed in response to the final rejection.

[1] Applicant contends that the amendment filed in response to the final rejection does place the instant application in condition for allowance because the subject matter of Claim 36 was indicated as allowable if rewritten to include all of the limitations of the base claim and any intervening claims as indicated in the final rejection, and because applicants responded to the indication of allowability by amending Claim 33 to include the recitation of claim 36. Thus, claim 33 is allowable and this amendment does place the instant application in condition for allowance.

This is not found persuasive for the following reasons:

[1] It is the examiner's position that the amendment does not place the instant application in condition for allowance because, for example, claim 2, which depends from claim 33, does not further limit the proposed amended claim 33. That is the proposed amendment of claim 33 included the limitation of claim 36, i.e. '*wherein the hydrophilic component comprises a polyalkylene oxide*', which change the scope of claim 33 by narrowing the scope of the generic claimed '*hydrophilic component*' to a single specific species, i.e. '*polyalkylene oxide*'. However, claim 2, which depends on claim 33, recite the limitation of "*wherein the hydrophilic component is a hydrophilic polymer, or a hydrophilic therapeutic, diagnostic, or prophylactic agent*" would not further limit the proposed amended Claim 33 because this limitation is broader in scope. In

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addition, claim 2 is not an intervening claim with regard to claim 36, i.e. claim 2 was never depend on claim 36. Therefore, the amendment filed in response to the final rejection is not entered because it does not place the instant application in condition for allowance.

In order to expedite the future prosecution of the present application the following comments are noted: As stated in 12/20/05 Office Action, "Claim 36 [not claim 33] would be allowable if ... [said claim] include[s] all of the limitations of the base claim [i.e., claim 33] and any intervening claim" (e.g., see 12/20/05 Final Action, page 7). Therefore, Applicants must incorporate the limitations of claim 33 into claim 36, not the other way around. This will prevent improper claim dependencies (e.g., claim 2, see above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on M: 8:00-2:30; Tues-Thur: 7:30-5:00; F: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PETER PARAS, JR can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mct
June 9, 2006

PETER PARAS, JR.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Peter Paras, Jr.", written in a cursive style.